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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/594,152	06/12/2000	Ryoichi Imanaka	MAT-3720US1	8730

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EXAMINER

PARRY, CHRISTOPHER L

ART UNIT	PAPER NUMBER
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2421

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/594,152	Applicant(s) IMANAKA, RYOICHI	
	Examiner CHRIS PARRY	Art Unit 2421	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3,4 and 7-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3,4 and 7-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Allowable Subject Matter

1. The indicated allowability of claims 3, 4, and 7-13 is withdrawn in view of the defective reissue declaration under 35 U.S.C. 251. Rejections based under 35 U.S.C. 251 follows.
2. The indicated allowability of claims 12 and 13 is withdrawn in view of the newly discovered reference(s) to Saito in view of Lett and further in view of Durden. Rejections based on the newly cited reference(s) follow.

Oath/Declaration

3. The reissue oath/declaration filed 19 March 2002 with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414.

The reissue declaration fails to specifically identify at least one error as just merely listing a claim as an error is insufficient. In addition, it is not sufficient to merely reproduce the claims with brackets and underlining and state that such will identify the error. See *In re Constant*, 827 F.2d 728, 729, 3 USPQ2d 1479 (Fed. Cir.), cert. denied, 484 U.S. 894 (1987). Any error in the claims must be identified by reference to the specific claim(s) and the specific claim language wherein lies the error. See MPEP § 1414 II(C).

Claim Rejections - 35 USC § 251

4. Claims 3, 4, and 7-13 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

Specification

5. The disclosure is objected to because of the following informalities: The specification must be amended to include a cross reference to all co-pending reissue applications at line 1 of the first page of the specification to patent number 5,790,172.

Appropriate correction is required.

Claim Objections

6. Claims 1-13 are objected to because of the following informalities: Any changes relative to the patent being reissued which are made to the specification, including the claims, upon filing, or by an amendment paper in the reissue application, must include the following markings: The matter to be omitted by reissue must be enclosed in brackets. Thus, all claims of the original patent should appear in the reissue patent, with canceled patent claims being enclosed in heavy brackets. See 37 CFR 1.173(d).

Appropriate correction is required.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saito (USPN 5,901,339) in view of Lett et al. "Lett" (USPN 5,592,551) [of record] and further in view of Durden et al. "Durden" (USPN 5,003,384).

Regarding Claim 12, Saito discloses a method for providing information on demand (Col. 7, lines 31-45) comprising the steps of:

receiving a request from a subscriber requesting information (i.e., applicant for viewing a broadcast program sends a viewing request) (Col. 7, lines 31-34 and Col. 4, lines 30-32);

transmitting the information to at least one of a subscriber display means (i.e., TV in fig. 2) and a subscriber recording means (i.e., VTR in fig. 2) for displaying and recording the information respectively (i.e., the received desired broadcasting program is displayed or recorded) (Col. 7, lines 39-40 and Col. 4, lines 35-42), and

charging the subscriber (i.e., the charging center receives the request and collects a fee for the program) (Col. 7, lines 35-38 and Col. 4, lines 30-35).

Saito is silent on disclosing charging the subscriber one of a plurality of amounts depending upon whether the transmitted information is intended for recording on said recording means.

In an analogous art, Lett discloses charging the subscriber one of a plurality of amounts (i.e., a fee to watch and record or no fee to watch) depending upon whether the transmitted information is intended for recording on said recording means (i.e., the user may watch a "free" preview of a PPV event or the user must purchase the event and is charged a fee in order to record the program) (Col. 14, lines 38-67 and Col. 4, lines 41-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Lett to include charging the subscriber one of a plurality of amounts depending upon whether the transmitted information is intended for recording on said recording means as taught by Lett for the benefit of charging the subscriber higher fees to facilitate providing the subscriber with the ability to watch a program multiple times.

Saito and Lett fail to disclose wherein said request for information indicates whether the subscriber is recording said information on said recording means.

In an analogous art, Durden discloses wherein said request (i.e., "Pre-Buy) for information indicates whether the subscriber is recording said information on said recording means (i.e., a subscriber has the ability to pre-buy a PPV event wherein a pre-buy allows the subscriber to record the PPV event and the record of the pre-buy or "subscriber request" is transmitted to system

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manager 8) (fig. 3; Col. 11, line 57 to Col. 12, line 14 and Col. 12, lines 56-66).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Saito and Lett to include wherein said request for information indicates whether the subscriber is recording said information on said recording means as taught by Durden for the benefit of increasing control and enhancing the diversity of an impulse pay-per-view system.

Regarding Claim 13, Saito discloses an apparatus (i.e., charging center and TV program broadcasting station – figs. 2 and 5) for providing information on demand (Col. 7, lines 31-45) comprising:

receiving means (i.e., public telephone line receiver on charging center) for receiving a request from a subscriber for information (i.e., applicant for viewing a broadcast program sends a viewing request) (Col. 7, lines 31-34 and Col. 4, lines 30-32);

sending means (i.e., TV program broadcasting station) for sending the information to at least one of a subscriber display means (i.e., TV in fig. 2) and a subscriber recording means (i.e., VTR in fig. 2) for displaying and recording the information respectively (i.e., the received desired broadcasting program is displayed or recorded) (Col. 7, lines 39-40 and Col. 4, lines 35-42), and

charging means (i.e., charging center) for charging the subscriber (i.e., the charging center receives the request and collects a fee for the program) (Col. 7, lines 35-38 and Col. 4, lines 30-35).

Saito is silent on disclosing charging means for charging the subscriber one of a plurality of amounts depending upon whether the transmitted information is intended for recording on said recording means.

In an analogous art, Lett discloses charging means (system manager 22 – fig. 2) for charging the subscriber one of a plurality of amounts (i.e., fee to watch and record or no fee to watch) depending upon whether the transmitted information is intended for recording on said recording means (i.e., the user may watch a "free" preview of a PPV event or the user must purchase the event and is charged a fee in order to record the program) (Col. 14, lines 38-67 and Col. 4, lines 41-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Lett to include charging means for charging the subscriber one of a plurality of amounts depending upon whether the transmitted information is intended for recording on said recording means as taught by Lett for the benefit of charging the subscriber higher fees to facilitate providing the subscriber with the ability to watch a program multiple times.

Saito and Lett fail to disclose wherein said request for information indicates whether the subscriber is recording said information on said recording means.

In an analogous art, Durden discloses wherein said request (i.e., "Pre-Buy") for information indicates whether the subscriber is recording said information on said recording means (i.e., a subscriber has the ability to pre-buy a PPV event wherein a pre-buy allows the subscriber to record the PPV event and the record of the pre-buy or "subscriber request" is transmitted to system

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manager 8) (Col. 11, line 57 to Col. 12, line 14 and Col. 12, lines 56-66).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Saito and Lett to include wherein said request for information indicates whether the subscriber is recording said information on said recording means as taught by Durden for the benefit of increasing control and enhancing the diversity of an impulse pay-per-view system.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRIS PARRY whose telephone number is (571) 272-8328. The examiner can normally be reached on Monday through Friday, 8:00 AM EST to 4:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN MILLER can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John W. Miller/
Supervisory Patent Examiner, Art Unit 2421

CHRIS PARRY
Examiner
Art Unit 2421

/C. P./
Examiner, Art Unit 2421